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REMARKS

Applicants thank the Examiner for the thorough consideration given the present application. Claims 1, 3, 6, 8, 11, and 15-22 are pending. Claims 1, 3, 6, 8, and 11 are amended to define Applicants' contribution to the art with greater particularity. Claims 15-24 are added to provide Applicants' with the protection to which they are deemed entitled.

The objection to claim 2 is rendered moot by the cancellation thereof. The objection to claim 3 is overcome by the amendment to claim 1. The indefiniteness rejection of claims 1-14 is rendered moot by the amendments to claims upon which claims 1, 3, 6, 8, and 11 depend.

Specifically, independent method claim 1, system claim 11, and processor claim 24 are directed to a first embodiment of the present invention and represent a combination of original claims 1 and 2. Independent method claim 15, system claim 22, and processor claim 23 are directed to a second embodiment of the present invention and present more fully the subject matter of original claims 1 and 4.

Original claim 2 described the illustrated embodiment wherein a user, who is first served a page without one or more content items, selects such a content item for display. The selection causes the one or more content items to be served either by

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reserving the page with the item incorporated therein, or by serving the content item for incorporation into the served page by the user's client entity.

Original claim 4 covered the embodiment discussed, for example, on page 8, lines 6-10, of the specification. In this embodiment, the server checks for a prior selection of content items by a user and incorporates any preselected items in the page being served.

As rewritten, the independent claims refer to only one content item solely for reasons of clarity and should not be construed as an abandonment of embodiments including multiple content items.

Applicants also wish to explain their reference to the content item being "incorporated for display" in the served page. As is known in the art, an image or object is not directly incorporated into an HTML page file as served by a server. Instead, the HTML page file includes a reference to the image file by using an image tag. For example, an image in image file "xyz.gif" is tagged:

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wherein border, width, and height are optional parameters for controlling image display. A browser reading the HTML file uses the image file reference to retrieve the image file "xyz.gif" and

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incorporate the image in the displayed page. Thus, the image is incorporated into the page by having its source reference included in the HTML page file.

Generally, in the present specification, the term "page" means the displayed page automatically assembled by the client browser on the basis of the retrieved HTML page file. If the retrieved HTML page file includes references to image files and/or objects, the referenced image files and/or objects are retrieved and automatically included in the page displayed to the user.

Embedding an object in the page refers to the inclusion of an object referenced in the HTML page file. Including the object itself would cause a browser to produce an error message since, when reading an HTML page, the browser expects to see plain text. See, in this regard, e.g., page 8, lines 12 and 13, of the present specification.

As now presented, claims 1-3, 9, 10-12, and 14 are not obvious as a result of Schreiber et al. (U.S. 6,298,446) in view of Wiser et al. (U.S. 6,385,596); and claims 4, 5, 7, and 13 are unpatentable over the combination of Schreiber, Wiser, and Dedrick et al. (U.S. 5,717,923).

While not acquiescing to any rejection, but solely to expedite prosecution, independent claim 1 is amended to recite a method of billing for access to a content item. The method

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includes the steps of (1) serving a page, without the content item, from a server to a client entity, the served page including an interface component enabling a user to select the content item for access; (2) serving the content item from the server to the client entity, in response to use of the interface component in the served page to select the content item, by either (a) serving the page again with the content item incorporated for display, or (b) serving the content item for display by the client entity in the previously served page at a location defined in the latter; and (3) generating a billing event at the server in correspondence to serving the content item.

Independent claim 11 is directed to a system corresponding to the method of claim 1, while claim 24 is directed to a processor arrangement for performing the method of claim 1.

Added independent claim 15 is directed to a method of billing for access to a content item associated with a page intended to be served from a server to a client entity. The method includes storing a corresponding selection indicator in the event of selection of said content item by a user associated with said client entity; receiving at the server a request for said page from said client entity and thereupon checking for any stored selection indicator indicating that the user associated with said client entity has selected the content item; where the

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checking of the database indicates that said user has selected the content item, serving the requested page with the content item incorporated for display in the page, the page otherwise being served without the content item also be served; and generating a billing event at the server in correspondence to serving the content item.

Independent claim 22 and claim 23 are respectively directed to a system and processor arrangement corresponding to the method of claim 15.

None of the cited references, including Schreiber, Wiser, and Dedrick, discloses or suggests a method or system having the features of claims 1, 11, 15, or 22-24.

Schreiber merely shows a method of securely displaying a protected image to prevent electronic copying. The image is provided to the client computer in encrypted form ("substitute data") which a substitute data processor (plug-in, applet or Active-X control; see column 10, lines 27 and 28) decrypts for display as part of the requested page, but for no other purpose. Unprotected images are handled in the above-noted standard manner.

As depicted in FIG. 2 of Schreiber, in response to a request for a web page being received at the server (step 210), a determination is first made (step 212) as to whether the page contains a reference to a protected image. Any references to

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protected images are then replaced by references to substitute data (step 214), while references to unprotected images are left unchanged.

In response to the client browser's receiving a page having reference to substitute data, the client browser retrieves that data (steps 220-226). References to unprotected images result in the browser retrieving the image data directly (steps 236-242) in a standard manner. Substitute retrieved data is then processed by the substitute data processor, and the protected image is displayed in the web page concerned (step 228). Unprotected images are displayed in the usual way (step 244).

Schreiber does not disclose or inherently include the amended independent claim 1 feature of serving the content item from the server to the client entity by either (1) serving the page again with the content item incorporated for display or (b) serving the content item for display by the client entity in the previously served page at a location defined in the previously served page. Nor does Schreiber provide any motivation that would lead one of ordinary skill in the art to modify its system to provide such a selection feature. As noted in the Office Action, Schreiber does not teach charging users for accessing content.

Wiser fails to cure the noted deficiencies of Schreiber. While Wiser discloses charging for access to media data downloaded

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from a server, the media data is not served again with the content item incorporated for display or served for display by the client entity in the previously served page, as claim 1 requires.

Rather, the media data is passed to a media player. See, for example, FIG. 7. Thus, if a music track listed in the web page illustrated in FIG. 8 is selected, the web browser makes a request to a server, which in due course returns a "media voucher". The browser passes this voucher to the media player, which is then responsible for accessing and playing the relevant media data. See the discussion at column 15, line 29, through column 16, line 25, of Wiser. Hence, neither Schreiber nor Wiser includes the foregoing features of claim 1, and claim 1 is patentable over these references.

In addition, one of ordinary skill in the art would not be motivated to combine Schreiber and Wiser, because the problem solved by Schreiber is not one encountered by Wiser. Schreiber is concerned with ensuring that valuable image data is only provided to the client browser in a format requiring a trusted substitute processor to render the data usable. Wiser does not deal with problem of protecting valuable data because either the data downloaded from the server is relatively low value media preview data or full media data for which the user has paid (so that there is no remaining value to protect with respect to that user).

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The combination of Schreiber and Wiser is also improper because one of ordinary skill in the art would not have combined the references as there is a far simpler way to obtain the result that would flow from the combination. It would be simpler to list images instead of music tracks (as per FIG. 8 of Wiser). Selection of a listed image would thereby cause that image to be displayed. The image listing could be done as an array of preview images, and the display of a selected image could be within the browser itself. However, motivation to combine references must come from the references themselves. There is no reason why one skilled in the art would be motivated by Schreiber and Wiser to incorporate a full image displayed into an image-listing page.

Moreover, combining these references prevents utilization of Schreiber's key feature, i.e., serving substitute data to the client. If this feature were to be used in a combination of Schreiber and Wiser, the substitute image data of Schreiber most likely would be provided at the same time as a page that lists the images available (for example, by an array of preview images). If a user wanted to see the full image, the user would select the preview, causing the substitute data processor to process the substitute data and display the image. At the same time, the substitute data processor would need to initiate a billing event.

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This is a very different arrangement from the method and system set forth in Applicants' independent claims 1 and 11.

Accordingly, amended claim 1 and the claims dependent on claim 1 are patentable over the combination of Schreiber and Wiser.

The rejection of claims 4 (the original claim corresponding most nearly to added independent claim 15), 5, 7, and 13 based on Schreiber, Wiser, and Dedrick is also improper.

First, as already discussed extensively, there is no motivation to combine Schreiber and Wiser. Second, Dedrick fails to cure the deficiencies of Schreiber and Wiser as primary references.

Dedrick discloses a method and apparatus for selecting content for display based on a personal profile. This is not the same as the requirements of claims 15, 22, and 23 for checking stored selection indicators indicating that the user associated with the client entity has selected the content item where checking the database indicates the user has selected the content items. At best, combining Dedrick with Schreiber and Wiser might lead one of ordinary skill in the art to an arrangement in which the list of images presented to the user for selection is generated on the basis of data contained in profile data for the user. This combination does not result in the foregoing features

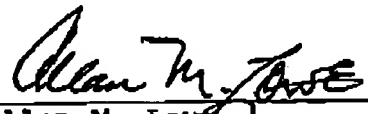
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of Applicants' independent claim 15. Based on the foregoing, claims 15, 22, and 23, and the claims dependent thereon, are not obvious as a result of Schreiber, Wiser, and Dedrick.

In view of the above amendments and remarks, favorable reconsideration of the rejections and allowance of the application are deemed in order.

To the extent necessary during prosecution, Applicants hereby request any required extension of time not otherwise requested and hereby authorize the Commissioner to charge any required fees not otherwise provided for, including extension, extra claims, and application processing fees, to Deposit Account No. 08-2025.

Respectfully submitted,
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